

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/964,147	9/26/2001	Richard Davidson	2001P10389US
EXAMINER			
Barry W. Taylor			
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REMARKS

Claims 1-20 are pending in the application. Claims 1, 2, 3, 7, 10, and 11 are amended for clarity as these claims are only reorganized using the same language. These amendments are not made for reasons of patentability and should not be construed as a narrowing amendment. Claims 12-20 are added for consideration by the Examiner. No new matter has been added. Reconsideration is hereby requested in view of the above amendments and following remarks.

35 U.S.C. §103(a) Rejections

The Examiner rejected claims 1-11 under §35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,991,367 to Robuck in view of U.S. Patent No. 6,542,596 to Hill, *et al.* ("Hill"). Applicants respectfully traverse this rejection.

In order to reject a claim under 35 U.S.C. §103(a), the MPEP mandates that three basic criteria must be met to provide a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the reference themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

Applicants submit that the references, either singly or when combined, fail to teach or suggest all the claimed features. Hence, there is no *prima facie* case of obviousness demonstrated.

In regards to claims 1-5 and 8-11, each of these claims recites, in part, for example:

- (i) determining whether the called party has a caller ID feature;
- (ii) determining whether a call is from a public telephone or from a private telephone number; and
- (iii) processing the call based, at least in part, on the results of these determinations.

For example, representative claim 1 includes, in part, "determining whether a call is from a

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public telephone or from a private telephone number" and "determining whether the called party has a caller ID feature" and based on affirmative results of the determinations, completing the call. Applicants submit that neither Robuck nor Hill, either singly or in combination, teaches or suggests, at least, these features as recited, in part, (or similar variations) in each individual claim 1-5, and 8-11.

In contrast, Robuck, is directed to a call screener installed at a user's telephone line to intercept incoming calls by preventing ring to the phone and asking the calling party to dial a random number. If the random number is dialed, Robuck completes the call by re-applying ringing to the phone. According to Robuck, the system does not depend on any caller-id (Abstract) and makes no decisions based on whether a called-party has caller-ID or whether a call is from a public or private number. Therefore, Applicant submits that Robuck does not teach or suggest, at least the features of the claimed invention directed to whether a call is from a public telephone or from a private telephone number, and whether the called party has a caller ID feature, and processing a call based on this determination.

However, the section of Robuck cited by the Examiner (col. 2, ll. 1-7) does not teach determining whether a call to a jurisdiction requires calls to be identifiable (or from a public number or similar variations). The cited section simply states that caller-ID works only on local calls as some out-of-state calls do not send their telephone numbers. This is not the same as a determining whether a jurisdiction requires a call to a called party to be identifiable (or from a public number or similar variations).

Hill does not compensate for the deficiencies of Robuck. Hill is directed to an intelligent network system for terminating calls to subscribers to a privacy screening service, when the calling party has a private number. Although, Hill appears to teach checking for private or public numbers, Hill does not teach or suggest determining whether the called party has a caller-ID feature. For example, at col. 3, ll. 40-45, Hill appears to show the step of checking a calling party ID, but this is not the same as checking whether a called party has a caller-ID feature. Further, at col. 5, ll. 24-26, Hill states

"For callers to caller ID deluxe, the LCD display on the subscriber's telephone will show, e.g., "Privacy Manager" as the calling party."

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Again, this does not teach, at least, the features of determining whether the called party has a caller-ID feature. Applicants therefore submit that neither Hill nor Robuck teach or suggest, singly or in combination, at least the step of determining whether the called party has a caller-ID feature.

Applicants further submit that Hill also does not teach or suggest at least the features determining whether a call is from a public telephone or from a private telephone number, and processing a call based on this determination, in addition to whether a called party has a caller ID, as recited, in part, by the inventions of claims 1-5 and 8-11. In Hill, caller-ID is a generally passive operation that always occurs at the final stage of a call (e.g., when ringing occurs) by sending information related to the calling party that may or may not be present. In Hill, all routing and processing decisions have effectively been completed when caller-ID information is finally addressed. Thus, Hill does not teach or suggest, at least, determining whether a called party has a caller-ID feature and whether the call is from a private or public number to base a decision on how to process the call (e.g., issuing an announcement) as recited, in part, by claims 1-5 and 8-11.

Further, in regards to claims 4, 5, 8-11, Applicants submit that neither Robuck nor Hill teach or suggest, singly or in combination, at least the features of determining whether a jurisdiction of a called party requires calls to be identifiable by the called party or from a public number. Further, Robuck and Hill do not teach or suggest basing a processing decision on whether a jurisdiction of a called party requires calls to be identifiable by the called party or from a public number. That is, nowhere in Robuck or Hill is there any teaching or suggestion of a step concerning a decision based on whether a jurisdiction requires a call to be identifiable or from a public number.

Applicants therefore submit that since Robuck and Hill, either singly or in combination, do not teach or suggest all the claimed features of claims 4, 5, 8-11. Applicants submit that the Examiner has thus failed to prove a *prima facie* case of obviousness and the rejection of claims 1-11 under §35 U.S.C. §103(a) should now be withdrawn.

As to claims 6 and 7, these dependent claims depend from independent claim 1, which Applicants submit is allowable. Applicants also submit that claims 6 and 7 are drawn to patentable subject matter and for at least due to their dependency from claim 1, are also allowable.

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New Claims 12-20

Support for claims 12 and 13 may be found, at least at, page 4, lines 17-24, and Figure 1, where it shows that the central office has a database which stores features and the central office stores a computer program for execution of steps of the invention as shown in Figure 2.

Support for claim 14 may be found, at least at, page 5, lines 13-15 and step 300 of Figure 2.

Support for claim 15 may be found, at least at, page 5, lines 16-19, where it states that a determination is made as to whether the incoming call is from a public telephone number or from a private telephone number.

Support for claim 16- 18 may be found, at least at, page 5, lines 16-25.

Support for claim 19 may be found, at least at, page 5, lines 25-30.

Support for claim 20 may be found, at least at, page 5, lines 16-19.

These new claims are also directed to allowable subject matter.

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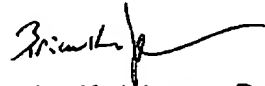
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Conclusion

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written petition for extension of time if needed. Please charge any deficiencies and credit any overpayment of fees to Deposit Account No. 19-2179.

Respectfully submitted,



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